

**REMARKS**

The Office Action dated June 20, 2006, has been received and carefully considered. In this response, claims 1, 2, 6, 10-12, 16, 18, 19 and 21-25 have been amended. Entry of the amendments to claims 1, 2, 6, 10-12, 16, 18, 19 and 21-25 is respectfully requested. Reconsideration of the outstanding rejections in the present application is also respectfully requested based on the following remarks.

At the outset, the undersigned thanks the Examiner for the courtesies extended during the Examiner Interview conducted on October 3, 2006, during which agreement was reached on overcoming the rejections regarding the inventor declarations, statutory subject matter, and prior art references, as reflected herein.

I. THE NON-STATUTORY SUBJECT MATTER REJECTION OF CLAIMS 1-18 AND 25

On page 7 of the Office Action, claims 1-18 and 25 were rejected under 35 USC § 101 as being directed to non-statutory subject matter. This rejection is hereby respectfully traversed with partial amendment.

Regarding claims 1-9 and 11-17, the Examiner asserts that these "claims fail to set forth the operation of the claimed elements are tangible embodied on an article of manufacture."

First of all, claims 1-9 and 11-17 do not recite anything regarding an article of manufacture. In contrast, claims 1-9 and 11-17 recite methods for outcomes monitoring (of surgical procedures). These methods recite steps that lead to the useful, concrete, and tangible result of "generating at least one outcomes monitoring report comprising the selected one of the at least one outcomes result and the norm." Additionally, these methods do not recite mathematical algorithms, as the Examiner implies. Indeed, the claimed steps of collecting, converting, establishing, and generating are clearly not part of a mathematical algorithm.

Applicants again respectfully submit that there is no patentable subject matter restriction against software programs as long as the claimed invention as a whole accomplishes a practical application. That is, it must produce a "useful, concrete and tangible result." State Street Bank & Trust Co. v. Signature Financial Group Inc., 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1601-02. As discussed above, claims 1-9 and 11-17 are all clearly directed to practical applications that produce a useful, concrete and tangible result.

Regarding claims 10, 18, and 25, in addition to the foregoing arguments, Applicants direct the Examiner to the case law set forth in In re Beauregard, 35 USPQ 2d 1383, 1384 (Fed. Cir. 1995), the recently decided In re Lundgren, (cite pending),

and others, which clearly provide a patentable subject matter basis for these claims. However, in view of the agreement reached during the Examiner Interview, Applicants have amended claims 10, 18, and 25 to remove any doubt regarding patentable subject matter. That is, claims 10, 18, and 25 have been amended to recite at least one processor readable carrier for storing a computer program of instructions configured to be readable by at least one processor for instructing the at least one processor to monitor outcomes by performing the steps of collecting, converting, establishing, and generating, which are clearly not part of a mathematical algorithm and are clearly directed to practical applications that produce a useful, concrete and tangible result.

In view of the foregoing, it is respectfully requested that the aforementioned non-statutory subject matter rejection of claims 1-18 and 25 be withdrawn.

## II. THE ANTICIPATION REJECTION OF CLAIMS 1-25

On pages 8-11 of the Office Action, claims 1-25 were rejected under 35 U.S.C. § 102(e) as being anticipated by Menzie et al. (U.S. Patent No. 6,650,932). This rejection is hereby respectfully traversed.

Under 35 U.S.C. § 102, the Patent Office bears the burden of presenting at least a prima facie case of anticipation. In re

Sun, 31 USPQ2d 1451, 1453 (Fed. Cir. 1993) (unpublished). Anticipation requires that a prior art reference disclose, either expressly or under the principles of inherency, each and every element of the claimed invention. Id.. "In addition, the prior art reference must be enabling." Akzo N.V. v. U.S. International Trade Commission, 808 F.2d 1471, 1479, 1 USPQ2d 1241, 1245 (Fed. Cir. 1986), cert. denied, 482 U.S. 909 (1987). That is, the prior art reference must sufficiently describe the claimed invention so as to have placed the public in possession of it. In re Donohue, 766 F.2d 531, 533, 226 USPQ 619, 621 (Fed. Cir. 1985). "Such possession is effected if one of ordinary skill in the art could have combined the publication's description of the invention with his own knowledge to make the claimed invention." Id..

The Examiner asserts that Menzie et al. discloses the claimed invention. However, Menzie et al. issued November 18, 2003, from U.S. Patent Application No. 09/750,683, filed May 15, 2000. Thus, Menzie et al. has an effective filing date of May 15, 2000.

Applicants again respectfully submit that the invention disclosed and claimed in the present application was conceived prior to May 15, 2000. Applicants also respectfully submit that they were duly diligent in preparing and filing the present application from the date of conception of the invention

disclosed and claimed in the present application to the filing date of the present application (i.e., November 20, 2001). Applicants have supported the above-stated submissions with inventor declarations under 37 C.F.R. § 1.131 and supplemental inventor declarations under 37 C.F.R. § 1.131, which were previously submitted, and which contain a showing of facts that clearly establish the above-stated submissions.

Specifically, and in accordance with the agreement reached during the Examiner Interview, Applicants respectfully submit that the prior submitted declarations provide a showing of conception prior to the Menzie reference date, as well as due diligence from prior to the Menzie reference date to both actual and constructive reduction to practice. Such a showing includes: 1.) a detailed invention disclosure (see Exhibit A of declarations); and 2.) proof of the active development of the system embodying the claimed invention as described in the invention disclosure (i.e., (1) a letter agreement, dated August 4, 1998, between Chironet and Social & Scientific Systems, Inc. (SSS), setting forth that SSS will provide advice on procuring hardware, software, and Internet connectivity; hypertext markup language (HTML) and graphics design services; computer programming; and ongoing technical support, all related to developing the system embodying the claimed invention as described in the invention disclosure (see Exhibit B of

supplemental declarations); (2) invoices from SSS to Chironet relating to the above-described agreement (see Exhibit C of supplemental declarations); (3) a marketing agreement between Surgical Outcomes (of which Chironet is an affiliate) and McKesson General Medical Corp. (McKesson), setting forth that McKesson will provide promotion and marketing services to Surgical Outcomes relating to the system embodying the claimed invention as described in the invention disclosure (see Exhibit D of supplemental declarations); and (4) a letter from Chironet to SSS requesting assistance in reviewing final documentation for the system embodying the claimed invention as described in the invention disclosure (see Exhibit E of supplemental declarations)). Also, upon completion of the active development of an initial version of the system embodying the claimed invention as described in the invention disclosure, Applicants filed U.S. Provisional Patent Application No. 60/252,129 on November 21, 2000. The present application claims priority to U.S. Provisional Patent Application No. 60/252,129.

At this point it should be noted that the actual date of conception need not be provided (and may be redacted, as Applicants have done) in a declaration, but actual dates of diligence must be provided (which Applicants have provided) (see MPEP 715.07).

In view of the foregoing, Applicants respectfully submit that Menzie et al. is not a proper prior art reference for application against the claims of the present application.

In view of the foregoing, it is respectfully requested that the aforementioned anticipation rejection of claims 1-25 be withdrawn.

III. THE ANTICIPATION REJECTION OF CLAIMS 1-3, 5-13, 15-19, AND 21-25

On pages 11-14 of the Office Action, claims 1-3, 5-13, 15-19, and 21-25 were rejected under 35 U.S.C. § 102(e) as being anticipated by Kraf et al. (U.S. Patent No. 5,299,119). This rejection is hereby respectfully traversed.

Regarding claims 1, 11, 19, 24, and 25, the Examiner asserts that Kraf et al. discloses the claimed invention. However, it is respectfully submitted that Kraf et al. fails to disclose, or even suggest, a method for outcomes monitoring comprising the steps of: collecting outcomes data sets for a plurality of individuals; converting at least some of the outcomes data sets into at least one outcomes result; establishing a norm for an outcomes data group, wherein the outcomes data group comprises a plurality of the outcomes data sets; comparing a selected one of the at least one outcomes result to the norm; and generating at least one outcomes

monitoring report comprising the selected one of the at least one outcomes result and the norm, as presently claimed. Specifically, Kraf et al. fails to disclose, or even suggest, collecting outcomes data sets for a plurality of individuals (e.g., patients). Rather, Kraf et al. discloses a device for performing automated calculations for a single patient over time for determining normal or abnormal heart rate variation. Kraf et al. does not disclose, or even suggest, calculations or comparisons with other patients, but rather only with one patient. Also, Kraf et al. does not disclose, or even suggest, calculations or comparisons with other medical procedures, but rather only with one medical procedure. Further, Kraf et al. does not disclose, or even suggest, calculations or comparisons with other organizations, but rather only with one organization at a time. Indeed, Kraf et al. does not disclose, or even suggest, a medical benchmarking system in any manner. In contrast, the present application discloses making benchmark (comparison) calculations across multiple patients for multiple medical procedures for the purpose of comparing multiple organizations. The present application claims the broader application to any unit of observation (e.g., patient) for any type of activity (e.g., procedure) for any outcome (e.g., indicator), across any organization (e.g., ambulatory surgery center).



At this point it should be noted that claims 1, 11, 19, 24, and 25 have been amended to clarify the aforementioned differences and further distinguish the presently claimed invention from Kraf et al.

In view of the foregoing, it is respectfully submitted that Kraf et al. fails to disclose, or even suggest, the claimed invention as set forth in claims 1, 11, 19, 24, and 25. Accordingly, it is respectfully submitted that claims 1, 11, 19, 24, and 25 should be allowable over Kraf et al..

Regarding claims 2, 3, 5-10, 13, 15-18, and 21-23, these claims are dependent upon independent claims 1, 11, 19, 24, and 25. Thus, since independent claims 1, 11, 19, 24, and 25 should be allowable as discussed above, claims 2, 3, 5-10, 13, 15-18, and 21-23 should also be allowable at least by virtue of their dependency on independent claims 1, 11, 19, 24, and 25. Moreover, these claims recite additional features which are not disclosed, or even suggested, by the cited references taken either alone or in combination.

At this point it should be noted that claims 2, 6, 10, 12, 16, 18, and 21-23 have been amended to correspond to the amendments made to claims 1, 11, 19, 24, and 25.

In view of the foregoing, it is respectfully requested that the aforementioned anticipation rejection of claims 1-3, 5-13, 15-19, and 21-25 be withdrawn.

IV. THE OBVIOUSNESS REJECTION OF CLAIMS 4, 14, AND 20

On pages 14-15 of the Office Action, claims 4, 14, and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kraf et al. (U.S. Patent No. 5,299,119) in view of Killcommons et al. (U.S. Patent No. 6,424,996). This rejection is hereby respectfully traversed.

Under 35 U.S.C. § 103, the Patent Office bears the burden of establishing a prima facie case of obviousness. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). The Patent Office can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of references. Id. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). That is, under 35 U.S.C. § 103, teachings of references can be combined only if there is some suggestion or motivation to do so. Id. However, the motivation cannot come from the applicant's invention itself. In re Oetiker, 977 F.2d 1443, 1447, 24 USPQ2d 1443, 1446 (Fed. Cir. 1992). Rather, there must be some reason, suggestion, or

motivation found in the prior art whereby a person of ordinary skill in the art would make the combination. Id..

The Examiner acknowledges that Kraf et al. fails to disclose the claimed feature of posting a report on a webpage, but asserts that Killcommons et al. discloses this claimed feature and thus the claimed invention would have been obvious in view of the combination of Kraf et al. and Killcommons et al.. However, Killcommons et al. issued July 23, 2002, from U.S. Patent Application No. 09/199,611, filed November 25, 1998. Thus, Killcommons et al. has an effective filing date of November 25, 1998.

Applicants respectfully submit that the invention disclosed and claimed in the present application was conceived prior to November 25, 1998. Applicants also respectfully submit that they were duly diligent in preparing and filing the present application from the date of conception of the invention disclosed and claimed in the present application to the filing date of the present application (i.e., November 20, 2001). Applicants have supported the above-stated submissions with inventor declarations under 37 C.F.R. § 1.131 and supplemental inventor declarations under 37 C.F.R. § 1.131, which were previously submitted, and which contain a showing of facts that clearly establish the above-stated submissions.

Specifically, and in accordance with the agreement reached during the Examiner Interview, Applicants respectfully submit that the prior submitted declarations provide a showing of conception prior to the Killcommons et al. reference date, as well as due diligence from prior to the Killcommons et al. reference date to both actual and constructive reduction to practice. Such a showing includes: 1.) a detailed invention disclosure (see Exhibit A of declarations); and 2.) proof of the active development of the system embodying the claimed invention as described in the invention disclosure (i.e., (1) a letter agreement, dated August 4, 1998, between Chironet and Social & Scientific Systems, Inc. (SSS), setting forth that SSS will provide advice on procuring hardware, software, and Internet connectivity; hypertext markup language (HTML) and graphics design services; computer programming; and ongoing technical support, all related to developing the system embodying the claimed invention as described in the invention disclosure (see Exhibit B of supplemental declarations); (2) invoices from SSS to Chironet relating to the above-described agreement (see Exhibit C of supplemental declarations); (3) a marketing agreement between Surgical Outcomes (of which Chironet is an affiliate) and McKesson General Medical Corp. (McKesson), setting forth that McKesson will provide promotion and marketing services to Surgical Outcomes relating to the system embodying

the claimed invention as described in the invention disclosure (see Exhibit D of supplemental declarations); and (4) a letter from Chironet to SSS requesting assistance in reviewing final documentation for the system embodying the claimed invention as described in the invention disclosure (see Exhibit E of supplemental declarations)). Also, upon completion of the active development of an initial version of the system embodying the claimed invention as described in the invention disclosure, Applicants filed U.S. Provisional Patent Application No. 60/252,129 on November 21, 2000. The present application claims priority to U.S. Provisional Patent Application No. 60/252,129.

In view of the foregoing, Applicants respectfully submit that Killcommons et al. is not a proper prior art reference for application against the claims of the present application.

Additionally, it is respectfully submitted that the aforementioned obviousness rejection of claims 4, 14, 20 has become moot in view of the deficiencies of the primary reference Kraf et al. as discussed above with respect to independent claims 1, 11, and 19. That is, claims 4, 14, 20 are dependent upon independent claims 1, 11, and 19 and thus inherently incorporate all of the limitations of independent claims 1, 11, and 19. Also, secondary reference Killcommons et al. fails to disclose, or even suggest, the deficiencies of the primary reference Kraf et al. as discussed above with respect to

independent claims 1, 11, and 19. Indeed, the Examiner does not even assert such. Thus, the combination of secondary reference Killcommons et al. with the primary reference Kraf et al. also fails to disclose, or even suggest, the deficiencies of the primary reference Kraf et al. as discussed above with respect to independent claims 1, 11, and 19. Accordingly, claims 4, 14, 20 should be allowable over the combination of secondary reference Killcommons et al. with the primary reference Kraf et al. at least by virtue of their dependency on independent claims 1, 11, and 19. Moreover, claims 4, 14, 20 recite additional features which are not disclosed, or even suggested, by the cited references taken either alone or in combination.

Additionally still, Applicants note that Killcommons et al. discloses assembling and communicating multimedia information with a browser and e-mail. In contrast, the claimed invention is directed toward automated performance outcomes benchmarking. That is, the present application and the claimed invention is not directed toward assembling and communicating multimedia information with a browser and e-mail in any manner. Thus, there would have been no suggestion or motivation to combine Killcommons et al. with any other reference directed toward benchmarking in any manner.

In view of the foregoing, it is respectfully requested that the aforementioned obviousness rejection of claims 4, 14, 20 be

withdrawn.

V. CONCLUSION

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

To the extent necessary, a petition for an extension of time under 37 CFR § 1.136 is hereby made.

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-0206, and please credit any excess fees to the same deposit account.

Respectfully submitted,

Hunton & Williams LLP

By: 

Thomas E. Anderson

Registration No. 37,063

TEA/vrp

Hunton & Williams LLP  
1900 K Street, N.W.  
Washington, D.C. 20006-1109

U.S. Patent Application No.: 09/996,475  
Attorney Docket No.: 58367.000003

Telephone: (202) 955-1500  
Facsimile: (202) 778-2201

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